

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Hild *et al.*

Serial No.: 09/532,937

Filed: April 22, 2000

For: METHOD AND SYSTEM FOR DESIGNATING REQUIRED DEVICE ATTRIBUTES
FOR EMBEDDING IN A WORLD-WIDE WEB DOCUMENT REQUEST

Confirmation No.: 9182

Group Art Unit: 2143

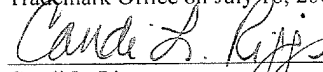
Examiner: David E. England

Date: July 18, 2007

Mail Stop Appeal Brief - Patents
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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on July 18, 2007.


Candi L. Riggs

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed May 22, 2007.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. § 1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

I. Status of the Present Application

A Decision on the appeal to the Board of Patent Appeals and Interferences (hereinafter "BPAI") filed on October 18, 2004 in the above referenced matter was mailed to Appellants on February 16, 2007. The decision affirmed the section 112 rejection with respect to Claim 21 and reversed the section 102 and 103 rejections. *See* Decision, page 5. In particular, the Decision affirmed the section 112 rejection "*pro forma* because appellants have not responded to the rejection." *See* Decision, page 3. Appellants respectfully submit that Appellants did not respond to the rejection because the rejection was specifically withdrawn in the Advisory Action of September 24, 2004. In particular, the Advisory Action states:

The amended section of claim 21 does overcome the 112 rejection stated in the Final Office Action dated 6/21/2004 but does not overcome the 103 rejection...

See Advisory Action of September 24, 2004, continuation sheet. Thus, the inclusion of the 112 rejection with respect to Claim 21 in the all three Examiner's Answers (May 5, 2005, September 8, 2006 and May 22, 2007) was improper.

Furthermore, a subsequent ORDER TO VACATE AND TO REMAND (hereinafter "Order") was mailed to Appellants on April 30, 2007 in the above referenced matter. The Order specifically acknowledges that the Advisory Action of September 24, 2004 states that the written description rejection of claim 21 was overcome. The Order further states:

Accordingly, we hereby VACATE only the portion of our February 16, 2007 Decision wherein we affirmed the rejection of claim 21 under the first paragraph of 35 U.S.C. § 112, and REMAND the application to the Examiner to determine whether the written description rejection applies to claim 21.

See Order, page 2. Thus, only the portion of the Decision with respect to Claim 21 was vacated,. As such, the section 102 and 103 rejections with respect to Claims 1, 2, 5-11, 12, 15-20, 21-22, 25-30, 32, 34 and 36-45 still stand reversed. *See* Decision, page 5. Accordingly, the Examiner's answer, which is basically identical to the Examiner's Answers of May 5, 2005 and September 8, 2006, is improper for at least the reasons discussed herein.

II. The Examiner's Answer is Improper

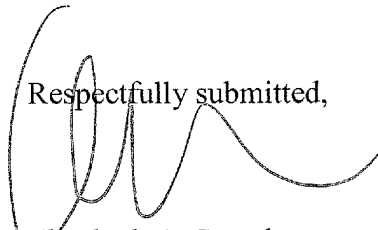
As stated above, the Examiner's Answer of May 22, 2007 is basically identical to the Examiner's Answers of May 5, 2005 and September 8, 2006. In particular, the only differences between the Examiner's Answer of May 22, 2007 and September 8, 2006 are on pages 30 and 31 of the May 22, 2007 Answer. In particular, the Examiner replaced the paragraph beginning "With these combinations of cited areas..." on page 30 of the September 8, 2006 Answer with the paragraph beginning "There is still no part in this section of the specification..." on page 30 of the May 22, 2007 Answer. Furthermore, on page 31 of the May 22, 2007 Answer, the Examiner removed the word "Although" from the beginning of the paragraph beginning "These sections say..." The Examiner has also added some additional highlighting in various places.

None of these changes is substantively relative to the section 112 rejection of Claim 21 which, as Appellants' understand it, is the only issue that was remanded to the Examiner.

Appellants do not understand why the Examiner's Answer of May 22, 2007 contains sections directed to rejections that have been reviewed and reversed by the BPAI, for example, 102 and 103 rejections that have been reversed by the BPAI. The Examiner's Answer even specifically states on the cover page that "it is in response to the appeal brief filed 02/02/2006," which is clearly incorrect. *See* Examiner's Answer of May 22, 2007, cover. Accordingly, Appellants will not address the details of the Examiner's Answer as Appellants submit that the entirety of the Answer is improper. Furthermore, Appellants have addressed all of the issues set out in the May 22, 2007 Answer twice, responsive to the May 5 Answer and the September 8 Answer. *See* Appellants' Reply Briefs of July 5, 2005 and October 8, 2006.

Thus, with respect to the only issue remanded to the Examiner, Appellants respectfully request that the section 112 rejection with respect to Claim 21 be reversed for at least the reason that the Examiner indicated in the Advisory Action of September 24, 2004 that the Section 112 rejection with respect to Claim 21 had been overcome. Thus, allowance of all of the pending claims is specifically requested.

Respectfully submitted,



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